

### REMARKS

The present application relates to hybrid maize plant and seed 39R62. Claims 1-43 are currently pending in the present application. Applicant respectfully requests consideration of the following remarks.

#### Detailed Action

##### *A. Claim Objections*

Applicant acknowledges the objection to claims 6, 12, 16, 25, and 29 are withdrawn in light of the claim amendments. Applicant further acknowledges the rejection of claims 1-32 under the judicially created doctrine of obviousness-type double patenting is withdrawn in light of the claim amendments. Applicant acknowledges the rejection of claims 1-32 under 35 U.S.C. § 102(e)/103(a) are withdrawn in light of the claim amendments.

##### *B. Specification*

The Examiner maintains his objection to the specification for containing blank lines on page 7 in the bottom paragraph stating that the blank lines appear to be in place of missing accession numbers for the inbred parents of 39R62, not 39R62 itself. Applicant respectfully submits that the actual ATCC deposit will be delayed until the receipt of notice that the application is otherwise in condition for allowance. While Applicant does not agree that this rejection is appropriate under 37 C.F.R. §§ 1.801-1.809, Applicant will refrain from deposit of Hybrid 39R62 and inbred parents GE570800 and GE533276 until allowable subject matter is indicated. Once such notice is received, an ATCC deposit will be made, and the specification will be amended to contain the accession number of the deposit, the date of the deposit, a description of the deposited biological material sufficient to specifically identify it and to permit examination and the name and address of the depository. The claims will also be amended to recite the ATCC deposit number. In addition, Applicant submits that at least 2,500 seeds of Variety 39R62 will be deposited with the ATCC. In view of this assurance, the rejection under 35 U.S.C. § 112, first paragraph, should be removed (MPEP § 2411.02). Such action is respectfully requested.

##### *C. Claims*

Applicant acknowledges the addition of new claims 44 through 65, as suggested by the claims faxed by Supervisory Patent Examiner Amy Nelson on August 2, 2002 and again on

November 15, 2002 by Examiner David Fox. The new claims do not add new matter as there is literal support for the claims in the originally filed specification (pages 29-41, specification).

**Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 11, 15, 19, 24, 28, and 32 remain rejected and claims 6, 8, 21, 33-43 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for the reasons of record stated in the July 3, 2002 office action. Applicant's arguments were fully considered but were not found fully persuasive. Amendments to claims 10, 14, 18, 23, 27 and 31 have overcome the aspect of the rejection regarding improper antecedent basis, and Applicant's assurance that the ATCC deposit number will be inserted upon notice of allowable subject matter overcomes the rejection regarding the term "39R62" for claims 1-32.

Claims 11, 15, 19, 24, 28 and 32 remain indefinite in their recitation of such adjectives as "excellent" and "above average" as these terms are unduly narrative and imprecise, and do not clearly set forth the degree of expression of the claimed characteristics or clearly characterize the corn plants exhibiting them.

Applicant has canceled claims 11, 15, 19, 24, 28 and 32, thus alleviating this rejection.

Claim 6 stands rejected as there is improper antecedent basis for the phrase "protoplasts" in line 1. Applicant has now amended claim 5 to read -- A tissue culture of regenerable cells or protoplasts --, thereby alleviating the rejection to claim 6.

The Examiner rejects claims 8 and 21 for the recitation "has been manipulated to be male sterile" renders the claims indefinite. It is not clear if the claim is directed towards detasseled plants, or plants that have been transformed with a gene conferring male sterility.

Applicant respectfully traverses this rejection. Applicant submits support can be found on page 13 of the specification, wherein it states "[i]t should be understood that the inbred can, through routine manipulation of cytoplasmic or other factors, be produced in male-sterile form. Such embodiments are also contemplated within the scope of the present claims." Further, the specification states hybrid maize seed is typically produced by a male sterility system incorporating manual or mechanical detasseling" (page 2, specification). In addition, the "detasseling process can be avoided by using cytoplasmic male-sterile inbreds" (page 2, specification). As taught in the specification there are several methods of conferring male

sterility. Therefore, Applicant asserts that one skilled in the art would not find the terminology indefinite. In addition, claim 21 has now been canceled, alleviating this rejection.

The Examiner states that claims 34, 36, and 39, and those dependent thereon stand rejected for the recitation "39R62" renders the claims, and those dependent thereon, indefinite. The Examiner continues by stating that amending the claims to indicate that seed of 39R62 was deposited under ATCC Accession No. \_\_\_\_\_ will overcome the rejection.

Applicant has canceled claims 34, 36, and 39, thus alleviating this rejection.

The Examiner rejects new claims 33 and 34 as they refer to two other corn lines, "GE570800 and GE533276". No morphological and physiological descriptions are provided at all for these two lines, and it is not clear what plants are referred to by these designations.

Applicant has canceled claims 33 and 34, thereby alleviating this rejection. Nonetheless, Applicant submits that the designation of GE570800 and GE533276 are the inbred parents of the hybrid as disclosed on page 7 of the specification. Applicant wishes to reiterate that under 37 C.F.R. §§ 1.801-1.809, Applicant will refrain from deposit of hybrid 39R62 and its parents until allowable subject matter is indicated. Once allowable subject matter is indicated, an ATCC deposit will be made, and the claims and the specification will be amended to contain the accession number of the deposit, the date of the deposit, a description of the deposited biological material sufficient to specifically identify it and to permit examination and the name and address of the depository thereby making this rejection will be moot.

Claim 36 stands rejected for the recitation "desirable morphological and physiological traits" in line 6 which renders the claim indefinite. The Examiner states it is not clear what traits one is to consider desirable versus undesirable.

Applicant has canceled claim 36, thus alleviating this rejection.

Claim 37 is rejected as the claim recites the recitation "the pedigree" in lines 1-2 and there is insufficient antecedent basis in the claim and the claim from which it depends for this limitation.

Applicant has canceled claim 37, alleviating this rejection.

Claim 40 stands rejected for the recitation "said population, on average, deriving at least 50% of its ancestral alleles" in line 2 as it renders the claim indefinite. It is not clear whether or not all of the claimed plants have at least 50% of the ancestral alleles from 39R62. The metes and bounds of the claim are not clear.

Applicant has canceled claim 40, thus alleviating this rejection.

The Examiner rejects claim 42 for the recitation "further comprising applying double haploid methods" as indefinite. The recitation broadens the scope of parent claim 39, which only involves crosses and does not encompass any double haploid method. The Examiner further states it is unclear what double haploid method is being referred to.

Applicant has canceled claim 42, thereby alleviating this rejection.

Claim 43 stands rejected for the recitation "a second plant" in line 9 which renders the claim indefinite. The Examiner states it is not clear if this second plant is different from or the same as the "second plant" mentioned in line 6.

Applicant has now canceled claim 43, alleviating this rejection.

In light of the above remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

#### **Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 11-19 and 24-32 remain rejected and claims 9, 10, 22, 23, and 33-43 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reason of record stated in the July 3, 2002 office action. Applicant's arguments were fully considered but were not found fully persuasive.

Applicant acknowledges the written description rejection to claims 8 and 21 as withdrawn. Applicant has now canceled claims 9-19 and 21-43, thus alleviating this rejection. Applicant has added new claims 44 – 65 as suggested by claims faxed by Supervisory Patent Examiner Amy Nelson on August 2, 2002 and again on November 15, 2002 by Examiner David Fox.

Claims 33-35 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for reasons of record stated in the July 3, 2002 office action for claims 1-32. Applicant's arguments have been fully considered and found persuasive for claims 1-32, however, Applicant's arguments were not persuasive for new claims 33-43.

Applicant has canceled claims 33-35, thus alleviating this rejection.

Claims 34 and 35 are rejected under 35 U.S.C. § 112, first paragraph, as the claims are broadly drawn towards a method of making an inbred plant comprising obtaining a hybrid maize plant 39R62 and generating from said plant a parental inbred parent line selected from the group consisting of GE570800 and GE533276; or wherein said generating step comprises using double-haploid breeding.

Applicant has canceled claims 34 and 35, thereby alleviating this rejection.

Claims 11, 15, 19, 24, 28, 32, 40, and 41 stand rejected under 35 U.S.C. § 112, first paragraph. The Examiner continues that the specification does not teach now one may determine that a descendent of 39R62, that expresses at least 2 of the traits listed in claim 11 for example, or any traits, could determine that at least 50% of its alleles were derived from 39R62, of any of its other ancestors also expressed those traits. Given the breadth of the claim, unpredictability of the art and lack of guidance of the specification as discussed above, undue experimentation would be required by one skilled in the art to make and use the claimed invention.

Applicant has canceled claims 11, 15, 19, 24, 28, 32, 40 and 41, thus alleviating this rejection.

In light of the above remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections to claims 9-19 and 22-43 under 35 U.S.C. § 112, first paragraph.

Applicant acknowledges claims 1-5, 7 and 20 are allowed.

### **Conclusion**

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested.

No additional fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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